

REMARKS/ARGUMENTS

The rejections presented in the Office action date April 29, 2005 have been considered. Claims 1-10 remain pending in the application. Reconsideration and allowance of the application is respectfully requested.

The undersigned attorney first thanks the Examiner for clarifying the prior rejection to Claim 7, and providing a non-final rejection allowing the Applicants to address the rejection. The Examiner's consideration is appreciated.

Claims 1, 4 and 6-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,073,104 to *Field* in view of U.S. Patent No. 5,666,553 to *Crozier*. The Applicants respectfully traverse the rejection. To establish a *prima facie* case of obviousness based on a combination of references, three basic criteria must be met, as is set forth in M.P.E.P., §2143:

- 1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art references must teach or suggest all of the claim limitations.

The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further, the prior art must suggest the desirability of the *combination* of the references. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

It is first respectfully submitted that the cited combination of references, when considered as a whole (M.P.E.P. § 2141), do not teach the method for facilitating financial transactions as set forth in Claim 1. Nevertheless, Claim 1 has been amended to facilitate prosecution of the application and in a *bona fide* attempt to advance the application to allowance. Claim 1 now addresses a manner in which individual sellers can be provided with specific access to their respective financial data at the central database, from which they can create their respective proposed investment contracts. This, among other claimed recitations, is not taught or suggested by a combination of *Field* and *Crozier*. Further, while the Office Action also identifies U.S. Patent No. 6,151,588 to *Tozzoli* in connection with an obviousness rejection to Claims 2-3, 5 and

7, *Tozzoli* also fails to teach or suggest at least this feature. Thus, a combination of *Field*, *Crozier* and *Tozzoli* fail to teach or suggest Claim 1, and therefore fail to meet the requirements of M.P.E.P. § 2143.

Further, the Applicants respectfully maintain arguments presented in prior responses. For example, the Applicants maintain that the cited portions of *Field* do not appear to teach or suggest a central database accessible by investment contract sellers authorized by investment contract buyers to receive the plan information. It appears that the information stored in the “central database” in the cited portion of *Field* is provided by a seller, where available buyers can access the information (*i.e.*, in connection with the sale of patient claims). Furthermore, it is respectfully submitted that the “approved payor” referenced in the Office Action is not relevant to any authorization in the context of the claimed invention. In this regard, these cited portions of *Field* fail to teach or suggest limitations directed to investment plan information at a central database accessible by potential sellers that are authorized by buyers (*e.g.*, where sellers can propose an investment contract for purchase by a buyer). Further, the Applicants reiterate that neither *Field*, *Crozier*, nor *Tozzoli*, either alone or in combination, appear to teach or suggest limitations directed to *proposed investment contracts* in the context of the present invention. The Applicants also maintain that there is insufficient motivation to combine the cited references.

In view of the amendments and remarks identified above, it is respectfully submitted that Claim 1 is patentable over the cited prior art of record. Reconsideration and allowance of Claim 1 is respectfully solicited.

Dependent Claims 4 and 6 are dependent from Claim 1, and also stand rejected as being unpatentable over the combination of *Field* and *Crozier*. While Applicants do not acquiesce with any particular rejections to these dependent claims, including any assertions concerning common knowledge, obvious design choice and/or what may be otherwise well-known in the art, it is believed that these rejections are moot in view of the amendments and remarks made in connection with independent Claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” M.P.E.P. §2143.03; *citing*

In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 4 and 6 are also allowable over the combination of *Field* and *Crozier*.

Regarding independent Claim 8, the Applicants maintain that these claims are allowable over the cited prior art of record. Claim 8 includes various means for performing functions, and it is respectfully submitted that the broadest reasonable interpretation that an examiner may give means-plus-function language is that statutorily mandated in 35 U.S.C. §112, ¶6. *In re Donaldson*, 16 F.3d 1189 (Fed. Cir. 1994). The test under §112, ¶6 requires that identity of function be determined, and it is respectfully submitted that a combination of *Field* and *Crozier* fails to teach the functions as claimed. For at least this reason, it is respectfully submitted that independent Claim 8 is patentable over the cited combination of references.

Claim 9 is dependent from Claim 8, and includes all the limitations of Claim 8. As set forth above, in an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. Further, it is respectfully submitted that Claim 9 includes means-plus-function claims in which the cited combination fails to teach the functions as claimed. Therefore Claim 9 is also in condition for allowance.

Independent Claim 10 was also rejected under 35 U.S.C. §103 based on the combination of *Field* and *Crozier*. The Applicants respectfully traverse the rejection. The Applicants again contend that no clear and particular evidence of a suggestion or motivation to combine *Field* and *Crozier* has been provided. Rather, it is respectfully submitted that the Applicants disclosure has been used as a blueprint to piece together pieces of the prior art in an effort to defeat patentability, which constitutes impermissible hindsight. (see, *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999)). Additionally, it is respectfully submitted that the combination of references does not teach or suggest all the claim limitations. By way of example, the cited combination fails to teach or suggest importing investment plan information based on both an import specification and data import map as set forth in the claim, or actually *designating* the investment contract sellers who are authorized by the investment contract buyers to receive the investment plan information. For at least these reasons, it is respectfully submitted that *prima facie* obviousness has not been established, and Claim 10 is not rendered obvious by the combination of *Field* and *Crozier*.

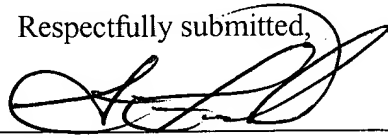
Claims 2-3, 5, and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Field* in view of *Crozier* as applied to claim 1, and in further view of U.S. Patent No. 6,151,588

to *Tozzoli*. The Applicants respectfully traverse the rejection. It is first respectfully submitted that Claim 1 as pending, and particularly as amended, is not taught or suggested by the combination of *Field*, *Crozier* and *Tozzoli*. *Tozzoli* does not remedy the deficiencies of the combination of *Field* and *Crozier*, and the combination fails to teach or suggest all the limitations of amended Claim 1. While Applicants do not acquiesce with any particular rejections to these dependent claims, including any assertions concerning common knowledge, obvious design choice and/or what may be otherwise well-known in the art, Claims 2-3, 5 and 7 include all of the limitations of Claim 1 and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Thus, dependent Claims 2-3, 5 and 7 are also allowable over the combination of *Field* and *Crozier*.

Further, it is again respectfully submitted that the Examiner's stated motivation to combine *Field* and *Tozzoli* fails to meet the standard for establishing *prima facie* obviousness. The stated motivation to combine the references is "to timely inform the user (seller/buyer) of any changes in contract, approval, acceptance, etc." It is respectfully submitted that this does not provide clear and convincing evidence of a motivation to combine the references, but rather provides a generic reiteration of what is provided in the rejected claims. For this additional reason, it is respectfully submitted that *prima facie* obviousness has not been established for the 35 U.S.C. §103(a) rejection to dependent Claims 2-3, 5 and 7.

The Applicants respectfully submit that the pending claims are allowable over the cited prior art of record, and that the application is in condition for allowance. Authorization is also hereby provided to charge/credit deposit account No. 50-3581 (HUEC.300US01) for any under/over payment in connection with the instant Office Action Response. If the Examiner believes it helpful, the undersigned attorney of record may be contacted at 952.854.2700 (x11) to discuss any issues related to this case.

Date: October 28, 2005

Respectfully submitted,

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